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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,792
Filing Date: January 03, 2004
Appellant(s): EDER, JEFF SCOTT

B. J. Bennett
For Appellant

EXAMINER'S ANSWER

This is in response to a brief filed on February 6, 2010 appealing from the Office action mailed February 6, 2009.

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(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

An Appeal for U.S. Patent Application 09/761,670 filed on January 19, 2001 may be affected by or have a bearing on this appeal. An Appeal for U.S. Patent Application 101743,417 filed on December 22, 2003 may be affected by or have a bearing on this appeal. An Appeal for U.S. Patent Application 101747,471 filed on December 29, 2003 may be affected by or have a bearing on this appeal. An Appeal for U.S. Patent Application 10/750,792 filed on January 3, 2004 may be affected by or have a bearing on this appeal.

(3) Status of Claims

Claims 1 through 20 are pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

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(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

PANT ET AL. US Patent 6,012,053

SANDRETTO US Patent 5,812,988

OFFICIAL NOTICE = APPLICANT ADMITTED PRIOR ART

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Specification

1. OBJECTION

The abstract of the disclosure is objected to because it contains reference marks to the specification and the drawings.

Applicant is requested to remove the reference marks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 182-187 and 193-197 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 175-197 recite a computer implemented method or process and storage device for determining the relevance of a key word. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)); *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Applicant is advised to satisfy the statutory requirements for the claims. The claims limitations must contain one of the statutory classes, such as an apparatus. Reference to the internet in the method claims limitations does not satisfy this requirement. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 175-197 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression "common schema" is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 175-197 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no

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concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression "common schema" is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 175-181 & 183-197 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (US Patent 6,012,053, hereafter Pant) in view of Sandretto (US Patent 5,812,988).

Re. Claims 175, 183, 188 and 193, with claim 193 as exemplary, Pant discloses a computer implemented keyword relevance method, storage device and system, comprising:

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- integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema (user input – Col. 1, ll. 54-55; Fig. 1, 108; Fig. 2, 108; Fig. 3, 152; Internet and external databases – Col. 3, ll. 14-32; a common schema is an obvious required factor since that is an implicit requirement for doing a search which has to be organized instead of being non-directional and meaningless, since any organized search will have a focused goal, i.e. a common schema);
- searching for a plurality of keywords on the Internet and in one or more external databases (col. 3, ll. 14-32),
- storing a location for each identified keyword (Fig. 3, 172; Fig. 4, 206),
- counting and classifying each stored keyword (Col. 1, ll. 56-62; Fig. 3, 168, 174, 176, 180),
- creating one or more keyword performance indicators (Fig. 3, 158, 166),

While Pant implies the integration of a plurality of data by the user in order to formulate his search, and then teaching the integration of data through the relevancy oriented search process, Pant does not explicitly disclose “integrating a plurality of data from a plurality of organization related systems”. However, Sandretto discloses integrating a plurality of data from a plurality of organization related systems (Abstract – ll. 1-2; Col. 8, l. 52 – Col. 9, l. 39; portfolio generation – Col. 8, ll. 58, 61, integrating data from a plurality of organization related systems – Col. 8, 61—Col. 9, l. 19).

Pant does not explicitly disclose

- developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and
- using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization where a plurality of keywords and classification information are obtained from user input.
- obtaining one or more keywords and a set of classification rules for each keyword from a user.

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However, Sandretto discloses a model of organizational financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators making use of user input (Col. 8, l. 52 – Col. 9, l. 39). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Pant for conducting relevance search with the art of Sandretto for developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators where a plurality of keywords and classification information are obtained from user input. Also, "obtaining one or more keywords and a set of classification rules for each keyword from a user " is an implicit part of the method disclosed by Pant and Sandretto and as such would have been an obvious component of determining the relevance to a keywords as disclosed in Pant (Col. 1, ll. 56-62; Fig. 3, 168, 174, 176, 180). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant and Sandretto with the practitioner's own knowledge in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

The clause "where keyword performance indicators are linked together when they are not independent" is not considered because it is Nonfunctional Descriptive Material. It does not further limit the claims (MPEP 2106, IV, 1. (b),).

Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197, the following limitations are not explicitly disclosed by Pant:

Re. Claims 176, 184, 189 & 194, wherein at least some data are pre-specified for integration and conversion

Re. Claims 177 & 185, wherein a plurality of integrated enterprise data are stored in an application database in accordance with a common schema.

Re. Claims 180, wherein a data processing method further comprises storing a plurality of converted data in one or more tables to support organization processing.

Re. Claims 181, 187, 192 & 197, wherein each keyword maps to the common schema.

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However, **Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197**, these steps would have been obvious to the ordinary practitioner at the time of Applicant's invention because they are logical elements of a computer automated search process.

Re. Claims 178, 185, 190 & 195, Pant does not explicitly disclose wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof. However, selecting a plurality of these related systems would have been obvious to the ordinary practitioner from the disclosure of Sandretto, for example capital asset systems, accounts receivable systems, accounts payable systems, inventory systems, etc.. (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant and Sandretto with the practitioner's own knowledge in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

Re. Claims 179, 186, 191 & 196, Pant does not explicitly disclose wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof. However, a common schema which identifies data designations such as components of value, sub components of value, known value drivers, elements of value, sub elements of value,

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non-relevant attributes and combinations thereof would have been obvious to the ordinary practitioner from the disclosure of Sandretto, including components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant and Sandretto with the practitioner's own knowledge in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

6. Claim 182 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pant et al. (US Patent 6,012,0563, hereafter Pant) in view of Sandretto (US Patent 5,812,988) as applied to claim 175 above, and further in view of Official Notice, which is now Applicant Admitted Art due to a lack of proper traversal of the Official Notice..

Re. Claims 182, wherein the program storage device comprises one or more intelligent agents (The examiner takes Official Notice that the use of intelligent agents were well known in the computer art at the time of Applicant's invention). Evidence - Intelligent agents are disclosed in US Patent 6,208,975 B1 to Bull et al., page 2, column 2, lines 11-12, dated December 1995 ("Intelligent agents for data searching").

(10) Response to Argument

Issue 1 – (Errors 1-38) "Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are patentable under 35 U.S.C. 103(a) given U.S. Patent 6,012,053 (hereinafter, Pant) in view of U.S. Patent 5,812,988 (hereinafter, Sandretto)?"

The claims are patentable because the claim rejections are based on hundreds of errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings

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fail to establish a prima facie case of obviousness for every rejected claim as detailed below.” (p. 11, ll. 13-19; p. 11, l. 13 – p. 21, l. 26 – Errors # 1-37).

Supporting Arguments:

Errors 1-10: All three prior art references (Pant - # 1, 2, 4, 7 and 9) and Sandretto (#21-22) teach away.

Errors 11-38. The obviousness rejections violate the statutes and case law governing the rejections and findings of obviousness.

Errors 11-24 violate various the guidelines of case law governing the reaching of obviousness conclusions by an examiner.

Errors 25-35 involve the change and destruction of the principle of operation, intent, purpose and function of the prior art inventions by combining or modifying them with the entire inventions of the cited secondary prior art

Errors 37 and 38: The rejections violate the Administrative Procedures Act (APA).

RESPONSE:

A. HUNDREDS OF ERRORS – No credible evidence of the hundreds of errors is presented by Appellant. Appellant claims 37 errors in support of "Issue #1". See the response below under the proper traversal standard.

B. IN THE MATTER OF LAW:

1) Guidelines for making a Proper Prima Facie Case of Obviousness according to the US Supreme Court's *KSR* Decision

a) BASES FOR OBVIOUS REJECTION

(1) Begin with the Graham vs Deere Analysis
Provide Facts.

- A disclosure in a non-analogous art which solves the problem is valid prior art
All elements do not have to be factually demonstrated.

(2) Valid Non-Factual Analysis – Must explain the differences between the prior art and what one of ordinary skill would have seen as obvious after consideration of the facts according to the following considerations:

- Common Sense

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- Obvious to Try
- Expected/Predictable Results
- Expectation of Success
- Design incentives or market forces would have made this improvement obvious
- The state of the art would have made the practitioner recognize the opportunity for improving upon the prior art.
- *In re Khan* factors – obvious or suggested to one of ordinary skill based on his knowledge – the “inferences and creative steps one of ordinary skill would employ”

(3). ORDINARY SKILL

An examiner may use their personal knowledge to describe the knowledge of one of ordinary skill and what such one would have seen as obvious from the evidence. If the examiner does not explicitly define the one of ordinary skill then the one of ordinary skill is defined by the relevant prior.

(4) FACTORS PROHIBITING A PRIMA FACIE CASE OF OBVIOUSNESS - i.e. ALLOWABILITY

- Unexpected/Unpredictable Results
- Technological barriers to satisfactory combination.
- Factors in the above rationales do not hold up to challenge

b) *In re Kahn*

The guidelines provided by *In re Kahn* as referenced in the US Supreme Court's decision of April 2007 in the case known as KSR, are as follows:

The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

2) THE ORDINARY PRACTITIONER or THE ONE OF ORDINARY SKILL: In the instant case, the ordinary practitioner would have been a single individual or more likely

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a team of practitioners. In the typical team found all over American business, the team would be working on a project basis as employees of a larger corporation or would be working together or independently on a consulting basis. The prior art of Pant represents the more common team as there are five inventors, whereas the prior art of Sandretto represents the less common individual who has all the knowledge required for developing the disclosed inventions. One or more team members would in this case have had the knowledge of quantitative tools for analyzing, forecasting risk analysis. Such techniques had been routinely taught for generations in MBA programs as well in undergraduate and graduate level business administration, economics and mathematics studies, computer science, engineering and various science fields of study. The other team members typically would have been practitioners of computer systems applications design, computer applications programming and computer applications hardware which had also been widely taught for decades and even generations. Such practitioner(s) were applying the techniques they learned in their academic studies as well as from ongoing professional learning and experience to the specific project needs of a business prior to Appellant's invention.

The examiner's Prima Facie Case of Obviousness: The rejections under 35 USC 103(a) in fact were made with the evidence provided by two patent references and presented

In the instant case, the examiner provided the evidence combined with some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, taking into account of the inferences and creative steps that a person of ordinary skill in the art would employ.

3) TRAVERSAL STANDARD

MPEP 2141, IV - TRAVERSAL

IV. APPLICANT'S REPLY

Once Office personnel have established the *Graham* factual findings and concluded that the claimed invention would have been obvious, **the burden then shifts to the applicant to (A) show that the Office erred in these findings or (B) provide other**

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evidence to show that the claimed subject matter would have been nonobvious. 37 CFR 1.111(b) requires applicant to distinctly and specifically point out the supposed errors in the Office's action and reply to every ground of objection and rejection in the Office action. The reply must present arguments pointing out the specific distinction believed to render the claims patentable over any applied references.

If an applicant disagrees with any factual findings by the Office, an effective traverse of a rejection based wholly or partially on such findings must include a reasoned statement explaining why the applicant believes the Office has erred substantively as to the factual findings. A mere statement or argument that the Office has not established a *prima facie* case of obviousness or that the Office's reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection or an effective traverse of the rejection under 37 CFR 1.111(b). Office personnel addressing this situation may repeat the rejection made in the prior Office action and make the next Office action final. See MPEP § 706.07(a).

4) TEACHING AWAY STANDARD

Appellant makes an improper citation of case law. The argument has a similar foundation as the teaching away argument. A combination which changes the principle of operation of the prior art has technical foundations and requirements. This can be seen in the court's detailed opinion in the case of *W.L. Gore & Associates v. Garlock, Inc.* This involves a teaching of "stretching said (unsintered) PTFE at a 10% per second rate to more than five times the original length. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE, would not have suggested rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly". Having read this court opinion, the examiner concludes that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible and thus the teachings could not be properly combined. Thus the court followed common sense logic, which was declared as legitimate in the Supreme Court's KSR decision. KSR states that there

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must be technological barriers to a satisfactory combination. This court illustration demonstrates that the “changing of the principle of operation” doctrine and the “teaching away” doctrine have essentially the same limited, narrow technical validity of a common sense variety. In the instant case of a business method, whether computer processor software automated or hand operated, the processes have few if any real technical limitations and/or barriers of the above scientific and/or technical nature found in the properties of materials. Further, the ordinary practitioner who is developing a business process would have no motivation for taking an entire process from the prior art such as those of Pant and Sandretto and attempt to merge the system designs and code together. The above rejections only take narrow teachings and suggestions from the references exactly for this reason. The practitioner either is knowledgeable in each of the majority of business method art areas necessary for a business method invention for patent or more often is composed of a plurality of inventors (i.e. an “A et al.” grouping). The needed knowledge and skills for this reason are one or more each of a business specialist (e.g. marketing, investment banking, manufacturing process, advertising, quantitative methods such as forecasting, economic or financial modeling, etc.), a systems analyst/designer, a programmer, and a hardware specialist. Thus the practitioner entity would not seek to combine a plurality of full processes but would merely incorporate narrow teachings and suggestions which he/they need to complete the functionality of the particular process purpose(s) output they are working on. The inventor practitioner entity would thus develop his/their own system design, code and hardware for operating the method steps. Such practitioners would see no benefit to attempting to somehow drag the entire processes of two or more prior art references and merge them together since no technical factors would require such mergings and no net benefits would be apparent. Therefore, Appellant would have to demonstrate why a software driven computerized process cannot combine a variety of narrow teachings and suggestions with a practitioner’s own process to achieve a desired overall process. Thus, an ordinary practitioner would have seen it as obvious to only take narrow teachings and suggestions in building a business process, including the claimed analytical process steps since software steps or human process steps can be

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modified virtually ad infinitum.

5) The Motivation to Combine Standard

In re Nomiya

The Examiner recognizes that “references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references”. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, (CCPA 1975)

In re McLaughlin

“There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art”. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

In re. Bozek

“and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures”. *In re Bozek*, 163 USPQ 545 9ccpa) 1969.

C. RESPONSE TO ARGUMENTS for Issue #1

1) The Obviousness Statute – Errors 11-24

“In other words, obviousness still requires a suggestion of all the limitations in a claim. Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited documents do not teach one or more limitations of the claimed invention include:” (p. 15. ll. 4-7).

As stated above regarding the making of a *prima facie* case of obviousness, the standard per *In re Kahn* is “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at

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1396.”. The examiner believes that he has provided the evidence combined with some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, taking into account of the inferences and creative steps that a person of ordinary skill in the art would employ. This has been done in the context of the indefiniteness issues (35 USC 112-2nd) affecting the independent claims as cited in the above rejections. Specifically, the mis-application of the obviousness statute does not require a “suggestion of all the limitations in a claim”. As such, the law does not support the statement that the rejections contain “Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited documents do not teach one or more limitations of the claimed invention”. The standard is that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”.

2) Traversal Standard – Errors 1-37 and the hundreds of errors.

a) Appellant fails to reach the proper traversal standard since the arguments fail to address the rejections of the specific limitations, the arguments fail to address specific limitations and the arguments fail to provide a combination of evidence and rationale sufficiently strong to put the examiner's rejections, made up of a combination of evidence and rationale, into serious question.

b) Appellant cites the failure to address limitations not claimed, such as the long list of optional items in claim 178. Since the "from the group of" standard only requires the examiner to select one such item, the examiner in fact documented four of the listed items in Sandretto repeated above on page 10, ll. 7-10.

3) TEACHING AWAY Arguments – Errors 1-10

Appellant fails present a valid case for teaching away because the arguments are merely assertions which are not anchored in the teaching away case law as illustrated above. Further, the arguments presented as errors are not supported by evidence plus rationale in a manner which puts the examiner's prima facie case of obviousness into serious question, as required by the case law cited above.

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For example, with Error #1, Appellant states “Error #1) Is a failure to acknowledge the fact that Pant teaches away from determining keyword relevance. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the development of objective measures of keyword relevance. Pant teaches away by teaching a method that identifies the relevance of a web page or document (Pant, Column 1, Line 65 through Column 2, Line 25). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.”.

COMMENTS:

- * Pant is the primary reference, so it is unable to teach away.
- * Pant and Sandretto are in the same field of endeavor.
- * The disclosures help to solve the problem the ordinary practitioners seek to solve.
- * Appellant fails to demonstrate how Pant teaches away beyond making a bold assertion, failing the traversal requirement. Pointing to a half a column of Pant’s disclosure (Col. 1, l. 65 – Col. 2, l. 25) does not demonstrate the claimed "fact" of “exclusively teaching away from the claimed invention”, particularly “a failure to acknowledge the fact that Pant teaches away from determining keyword relevance. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the development of objective measures of keyword relevance. Pant teaches away by teaching a method that identifies the relevance of a web page or document”.

In another example, Error # 3, Appellant asserts “Error #3) Is a failure to acknowledge the fact that Sandretto teaches away from the claimed development of a model of organization financial performance by category of value. Sandretto teaches away from every aspect of the claimed invention. Claim 175 teaches and relies on the fact that there are at least three categories of organization value the value of current operation cash flow, the value of market sentiment and the value of the real options. Sandretto teaches away by teaching that there is only one category of value, cash flow (see table below).

/Organization value per 10/750,792: Organization value = value of current operation

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cash flow + value of market sentiment + value of real options/

/Organization value per Sandretto: Value of cash flow/

By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182'. (The display is changed for typographical reasons)".

COMMENT: Appellant makes a bold assertion without meeting the traversal standard by not providing a combination of evidence combined with rationale to put the examiner's combination of evidence and rationale of what the ordinary practitioner would have seen as obvious based on his/their own knowledge. As such, Appellant fails to demonstrate in a reasonable manner why Andretto teaches away as asserted.

Re. the teaching away arguments for errors 1-10, Appellant uses the same assertions without meeting the standard of a proper traversal.

C. Examples of Faulty Traversals

Overview: The faulty logic in Appellant's improper traversals is in failing a combination of the above listings of law applicable to obviousness analysis and related rejections. Appellant mis-represents the various guidelines of KSR, In re Kahn, the ordinary practitioner, traversal, teaching away and motivation to combine.

1) KSR Guidelines:

- a) Begin with the Graham vs Deere Analysis – The examiner has followed this format by showing the relevant teachings in a primary reference (facts) in Pant, then showing what Pant does not teach, then showing what Sandretto teaches and also explaining what would have been obvious to one of ordinary skill at the time of Appellant's invention.
- b) The examiner made use their personal knowledge to describe the knowledge of one of ordinary skill (defined above and represented by the prior art) and what such one would have seen as obvious from the evidence. Further, If the examiner does not explicitly define the one of ordinary skill then the one of ordinary skill is defined by the relevant prior.
- c) The examiner believes that Pant and Sandretto are in the analogous art. However, since they help solve the problem they would be valid even if they were not in the analogous art.
- d) The examiner has made use of some of the analytical techniques permitted by KSR, such as:

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- *In re Khan* factors – obvious or suggested to one of ordinary skill based on his knowledge – the “inferences and creative steps one of ordinary skill would employ”
 - Common Sense
 - Obvious to Try
 - The state of the art would have made the practitioner recognize the opportunity for improving upon the prior art.
- e) The examiner considered the factors which would have led to allowance, including:
- Unexpected/Unpredictable Results – not the case since the searching of data bases making use of algorithms produces expected results. The only factor involved which may produce unexpected results through Appellant's claimed limitations is directly related to the vague and indefinite nature of Appellant's claimed limitations, as explained in the rejections under 35 USC 112-2nd paragraph.
 - There are no known technological barriers to satisfactory combination of various disclosures and suggestions in constructing a hand driven or software driven computer automated method and system. The main variations would be in efficiency, which is not claimed and is not aspect of the disclosure..

Re. the argument that “obviousness still requires a suggestion of all the limitations in a claim” –p. 15, ll. 4-5, under Errors 11 through 24 from p. 14) – this is simply a misunderstanding or mis-representation of the above guidelines, since an ordinary practitioner may see certain limitations as obvious based on their own knowledge of the art of their invention. Such practitioners, as described above, do not proceed to construct a business method and system with a blank slate of knowledge in the art of the invention. This is explained by the examiner’s rationale in the rejections.

2) Examples of Improper Traversals

Examples of Appellant’s traversals lacking the combination of evidence combined with rationale sufficient to put the examiner’s prima facie case of obviousness into serious question are:

(a) TEACHING AWAY, including a Reference Destroying the intent, purpose or function of an invention

“**Error #1 - Error #1)** Is a failure to acknowledge the fact that Pant teaches away from determining keyword relevance. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the development of objective measures of keyword relevance. Pant teaches away by teaching a method that identifies the relevance of a web page or document (Pant, Column 1, Line 65 through Column 2, Line 25). By exclusively teaching methods that teach away from the claimed invention, Pant provides

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additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.”. (pp. 11-12).

RESPONSE:

* No evidence or rationale is provided as to how the primary reference Pant can teach away. Merely bold assertions are made.

* No evidence and rationale are directed to the obviousness rationale provided by the examiner, the guidelines for obviousness and related combination. The vague and indefinite nature of the claimed limitations are mis-interpreted and/or ignored.

* Appellant makes bold assertions of Pant’s teaching away without providing the required evidence of how a such a teaching away is possible. Further, Appellant provides no teaching away evidence from the prior art references or from any other source.

“**Error #10)** Is a failure to acknowledge that Sandretto teaches away from the claimed method of data management. Claims 176 and 177 teach that some data are pre-specified for integration and conversion from a plurality of systems. Sandretto teaches away by teaching that only 3 variables are required and that the user can provide the required data input (see Sandretto, Column 3, Line 21 through Line 25). Furthermore, values for the three variables are not generally found in the claimed systems. By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 176 and claim 177.” (p. 14).

RESPONSE:

* No evidence or rationale is provided as to how the secondary reference Sandretto can teach away.

* No evidence and rationale are directed to the obviousness rationale provided by the examiner, the guidelines for obviousness and related combination. The vague and indefinite nature of the claimed limitations are mis-interpreted and/or ignored.

* Appellant makes bold assertions of Pant’s teaching away without providing the required evidence of how a such a teaching away is possible. Further, Appellant

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provides no teaching away evidence from the prior art references or from any other source.

* No evidentiary support combined with rationale is provided to support the assertion that "Sandretto teaches away by teaching that only 3 variables are required and that the user can provide the required data input (see Sandretto, Column 3, Line 21 through Line 25). Furthermore, values for the three variables are not generally found in the claimed systems."

"Error #28) One principle of operation that Sandretto relies on is that external, economic conditions determine enterprise cash flow (see Sandretto, Column 37, Lines 37 - 58). This principle of operation would have to be changed to replicate the functionality of the claimed invention and recognize the fact that elements of value and/or keywords may drive cash flow (aka the current operation) and the other categories of organization value. Affects all claims."(p. 17).

RESPONSE:

No combination of evidence and rationale is provided as to how this would occur under the manner in which the examiner's *prima facie* case of obviousness is constructed.

D. THE REJECTIONS UNDER 35 USC 103(a) --- Conclusion re. Errors 1-38

1) Appellant presents bold assertions which are not supported by proper traversals which require the traversal to provide a combination of evidence and rationale sufficient to put the examiner's *prima facie* case of obviousness into serious question.

2) Appellant's broad claim construction established vague and indefinite claims limitations in the independent claims which require the examiner to make the broadest reasonable interpretations of the claimed limitations. As such, the examiner searched the prior art and identified prior art which analogous and which solves the broad problems of the vague and indefinite limitations.

3) EXAMPLES:

Example (a) "Errors #11 through #17) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitation of claim 175 (affects claims 176, 177, 178, 179, 180, 181 and 182), including:

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- a) *integrating a plurality of data from a plurality of organization related systems, user input and an Internet in accordance with a common schema and an xml metadata standard (#11),*
- b) *obtaining one or more keywords and a set of classification rules for each keyword from a user (#12),*
- c) *searching for a plurality of keywords on the Internet and storing a location for each identified keyword (# 13),*
- d) *counting and classifying each stored keyword (#14),*
- e) *creating one or more keyword performance indicators where keyword performance indicators are linked together when they are not independent (#15),*
- f) *developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators (#16), and*
- g) *using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization (#17). “. (p. 15).*

Example (b) *“Error #18) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 176, including: where some data are pre-specified for integration and conversion.*

Error #19) *Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 177, including: *integrated enterprise data that are stored in an application database in accordance with a common schema.**

Error #20) *Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 178, including: *obtaining data from systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling**

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systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.

Error #21) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 179, including: *a common schema that identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.*

Error #22) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 180, including: *storing a plurality of converted data in one or more tables to support organization processing.*

Error #23) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 181, including: *wherein each keyword maps to the common schema.*

Error #24) Is a failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 182, including: *wherein the program storage device comprises one or more intelligent agents.* "(pp. 15-15).

CONCLUSION: These arguments fail the requirements of a proper traversal since they are assertions without the required evidence and rationale sufficient to put the examiner's. There is no attempt to provide evidence or rationale.

Re. Issues 2-12

As is the case with the arguments in Issue #1, Appellant presents bold assertions which are not supported by traversals which meet the standard of a proper traversal required by the case law cited above, which requires the traversal to provide a combination of evidence and rationale sufficient to put the examiner's *prima facie* case of obviousness into serious question. Further, Appellant mis-characterizes case law, such as the guidelines for the making of a proper a *prima facie* case of obviousness such as given in KSR and *In re Kahn*, regarding motivation to combine and teaching away.

Re. "Issue 2 - Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

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The claims are patentable because the claim rejections are based on over a hundred errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.” (p. 21, ll. 27-32; p. 21, l. 27 – p. 23).

RESPONSE:

Example with Error 35:

Appellant quotes *In re. Kahn* (as cited above by the examiner) and then states “In particular, the Examiner has not explained what would motivate someone of average skill in the art to destroy the functionality of the Pant invention and modify the principles of operation of both Sandretto and Pant as discussed under error 24 through error 31. This explanation is particularly important when one considers that Sandretto teaches away from all claimed methods and/or fails to teach or suggest almost every claim limitation as discussed under errors 1 through 23. In place of an explanation with articulated reasoning and a rational underpinning the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law. This includes the errors in the law identified under errors 32 through 34. Because no rational underpinning has been provided to support the legal conclusion of obviousness, the prima facie case of obviousness cannot be properly established.”.

Listing of Arguments:

- 1) No motivation to combine Sandretto with Pant.
- 2) No motivation to destroy the functionality of the Pant invention and modify the principles of operation of both Sandretto and Pant.
- 3) Sandretto teaches away from all the claimed methods.
- 4) the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law.
- 5) no rational underpinning has been provided to support the legal conclusion of obviousness

RESPONSE:

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1) Motivation Arguments

As stated above regarding the standard for motivation to combine

a) “there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references”. *In re Nomiya*.

b) “There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art”. *In re McLaughlin; and*

c) “references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures”. *In re Bozek*.

In the instant case, the examiner has followed these guidelines in making cases of obviousness in the rejections repeated above and being argued by Appellant by citing a motivation to combine from the prior art, by defining the one(s) of ordinary skill and by providing the rationale as to what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.

2) No destruction of functionality is involved or suggested in the rejections. As stated above in the interpretation of case law, the inventions of Pant and Sandretto are not being combined. The knowledge of the ordinary practitioner at the time of Appellant’s invention is represented not only by the prior art but also by the examiner’s explanation above. This means that such practitioner(s) already knew how to construct their basic method and system, needing only special disclosures to import. Only the narrow disclosures cited in the rejections are combined with the knowledge of the one of ordinary skill at the time of Appellant’s invention. The inventions of Pant and Sandretto are left alone since there would have been no motivation or scientific or technical principle for the ordinary practitioner to import the entire inventions of Pant and Sandretto into the basic process they already know how to construct. Thus the inventions of Pant and Sandretto are left untouched and are not combined or destroyed.

3) The response to arguments regarding teaching away are stated above in the response to Issue #2. There is no teaching away applicable to the rejections.

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4) Appellant has not made a proper traversal to support the allegations of several dozen errors, or even of the 38 errors and the hundreds of errors Appellant alleges have been made by they examiner in the various rejections.

5) The examiner has indeed provided rational underpinning for the rejections, especially for the rejections of the independent claims repeated above because the examiner has followed the *Graham v Deer* format in the rejections under 35 USC 103(a) and under the *In re Kahn* format. The examiner has provided evidence from Pant and Sandretto and rationale and motivation to combine.

Re. Issue 3 – “Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?”

The claims are patentable because the claim rejections are based on over a hundred errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.” (p. 23, ll. 24-29; p. 23, l. 24 – p. 25, l. 23).

RESPONSE:

Appellant repeats the arguments from Issue #1 and adds some additional allegations.

The Arguments and allegations include teaching away (errors 1-10), do not teach one or more limitations (errors 11-23), changing the principles of operation of Pant or Sandretto (errors 24-31), failure to meet any of the statutory requirement (n unsupported bold broadside assertion), the above KSR and *In re Kahn* assertions re. failure to produce a proper prima facie case of obviousness (error 35) and failure to meet the requirements of the APA (errors 36 and 37). None of these allegations are supported with proper traversals.

Issue 4 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?”

The claims are patentable because the claim rejections are based on over a hundred errors in the facts and in the law. Because of these errors, the cited combination of

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teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.” (p. 25, ll. 24-29; p. 25, l. 24 – p. 27, l. 16).

RESPONSE:

Appellant’s cited “errors” are identical to those in Issue # 3 above.

“Issue 5 - Whether claim 183, claim 184, claim 185, claim 186 and claim 187 represent patentable subject matter under 35 U.S.C. 101 ?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of non statutory subject matter for every rejected claim as detailed below.” (p. 27, ll. 17-2; p. 27, l. 17 – p.).

RESPONSE:

1) THE MATTER OF LAW - 101 - Bilski

The law in the area of patent-eligible subject matter for process claim has recently been clarified by the Federal Circuit in, *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), petition for cert. filed, 77 USLW 3442 (U.S. Jan. 28, 2009) (No. 08-964). The en banc court in *Bilski* held that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *In re Bilski*, 545 F.3d at 956. The court in *Bilski* further held that "the 'useful, concrete and tangible result' inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]" *In re Bilski*, 545 F.3d at 959-60. The court explained the machine-or-transformation test as follows: "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d at 954 (citations omitted). The court explained that "the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility" and "the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity."

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In re Bilski, 545 F.3d at 961-62 (citations omitted). The court declined to decide under the machine implementation branch of the inquiry whether or when recitation of a computer suffices to tie a process claim to a particular machine. In re Bilski, 545 F.3d at 962. As to the transformation branch of the inquiry, however, the court explained that transformation of a particular article into a different state or thing "must be central to the purpose of the claimed process." In re Bilski, 545 F.3d at 962. As to the meaning of "article," the court explained that chemical or physical transformation of physical objects or substances is patent-eligible under § 101. In re Bilski, 545 F.3d at 962. The court also explained that transformation of data is sufficient to render a process patent-eligible if the data represents physical and tangible objects, i.e., transformation of such raw data into a particular visual depiction of a physical object on a display. In re Bilski, 545 F.3d at 962-63. The court further noted that transformation of data is insufficient to render a process patent-eligible if the data does not specify any particular type or nature of data and does not specify how or where the data was obtained or what the data represented. In re Bilski, 545 F.3d at 962 (citing In re Abele, 684 F.2d 902, 909 (CCPA 1982) (process claim of graphically displaying variances of data from average values is not patent-eligible) and In re Meyer, 688 F.2d 789, 792-93 (CCPA 1982) (process claim involving undefined "complex system" and indeterminate "factors" drawn from unspecified "testing" is not patent-eligible).

2) Re. the rejections under 35 USC 101, Appellant's independent method claims 183 and 193 lack the required statutory component of a machine, such as a programmed computer. Further, Appellant cites in arguing errors 5 and 6.

It is true that method claims 183-187 and 193-197 must currently be evaluated under the machine-or-transformation test of *Bilski*. Independent claims 183 and 193 recite methods for determining the relevance of a key word. These independent claims only recite steps and do not tie these steps to a particular machine or apparatus. First of all, none of the steps recite the use of a processor, these steps are not limited to a specific machine or apparatus. Additionally, the steps recited by the claims are for determining the relevance of a key word. A method for determining the relevance of a key word does

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not transform an article into a different state or thing. As such, claims 183-187 and 193-197 fail to satisfy both prongs of the machine- or-transformation test and are rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

“Issue 6 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 represent patentable subject matter under 35 U.S.C. 101 ?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of utility and/or non statutory subject matter for every rejected claim as detailed below.” (p. 31, ll. 8-13; p. 31, ll. 8-29).

RESPONSE:

Re. method claim 193, please see the response under Issue # 5 above.

Re. dependent claims 194-197, they are rejected because of their dependence on rejected claim 193.

Issues 7, 8 and 9

“Issue 7 -Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.” (p. 31, l. 30 – p. 32, l. 2; p. 31, l. 31 – p. 36, l. 32).

“Issue 8 - Whether claim 183, claim 184, claim 185, claim 186, claim 187, claim 188, claim 189, claim 190, claim 191 and claim 192 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on over a hundred errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.” (p. 36, l. 1-5; p. 36, l. 14 – p. 38, l. 14).

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“Issue 9 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.” (p. 38, ll. 15-19; p. 38, l. 15 – p. 39, l. 15).

RESPONSE:

The rejections under 35 USC 112-1st paragraph are repeated above.

The rejections rationale gives articulated reasoning regarding why the specification is not enabling. This rationale is repeated for the reader’s convenience:

“The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression “common schema” is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.”.

2) DECLARATIONS: Further, Appellant argues in Issue \$ 7, error #5 that the declarations submitted by Appellant provides evidence to support the assertion that the

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specification is enabling. However, the record in the office action mailed on November 17, 2008 (page 9) shows that the declaration(s) by Dr. Peter Brous and Dr. Rick Rauenzahn submitted by Appellant do not meet the requirements of the MPEP. These declarations are not valid because they only refer to the invention and fail to refer to the claims in this application (MPEP 716, 37 CFR 1.132)..

Issues 10, 11 and 12

“Issue 10 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of claim indefiniteness for every rejected claim as detailed below.” (p. 39, ll. 16-20; p. 39, l. 16 – p. 43, l. 1).

“Issue 11 - Whether claim 183, claim 184, claim 185, claim 186, claim 187 claim 188, claim 189, claim 190, claim 191 and claim 192 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.” (p. 43, ll. 2-7; p. 43, ll. 2 - 30).

“Issue 12 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.” (p. 43, l. 31 - p. 44, l. 2; p. 43, l. 31 – p. 44, l. 23).

RESPONSE:

The rejections under 35 USC 112-2nd paragraph are repeated above.

The rejections rationale gives articulated reasoning regarding why the claims are indefinite. This rationale is repeated for the reader’s convenience:

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“The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression “common schema” is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.”.

Issue 13 - Informalities not identified by the Examiner.

Claims 177, 178, 179, 180, 185, 186, 190, 191, 195 and 196 contain the phrase "wherein a" that should in all cases be changed to "wherein the".

RESPONSE: Such amendments are not permitted in an Appeal Brief.

Re. Applicant Admitted Prior Art used in the rejection of dependent claim 182:

Appellant failed to traverse the Official Notice given in the non-final rejection mailed June 17, 2008. Appellant failed to traverse the Official Notice in the next response received June 27th and July 22, 2008. The Appeal Brief also fails to traverse the Official Notice. Thus, the Official Notice has become Applicant Admitted Prior Art.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Siegfried E. Chencinski/

Examiner, Art Unit 3695

Conferees:

Charles Kyle /CRK/

Supervisory Patent Examiner, Art Unit 3695

Alexander Kalinowski/A. K./

Supervisory Patent Examiner, Art Unit 3691